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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,957	08/08/2001	Shell S. Simpson	10015146-1	2075

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
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EXAMINER

ZHOU, TING

ART UNIT PAPER NUMBER

2173

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/923,957

Applicant(s)

SIMPSON ET AL.

Examiner

Ting Zhou

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. The amendment filed on 2 July 2004 have been received and entered. Claims 1-12 as amended are pending in the application.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 7 recite a group composition store that “is not associated with the at least one graphic store” and a plurality of different user profiles that are “not associated with the group composition store”, on lines 3-4 and 7-8 of claim 1 and lines 4-5 and 9-10 of claim 7. However, in claims 1 and 7, the limitations “with each different composition referencing at least one graphic in the at least one graphic store” and “each user profile including a reference to the group composition store”, on lines 4-5 and 10-11 of claim 1 and lines 5-6 and 11-12 of claim 7, make it indefinite and unclear how the group composition store can be not associated with the graphic store when the compositions within the group composition store references the graphics in the graphics store and similarly how the user profiles can be not associated with the group composition store when the user profiles include a reference to the group composition store.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Marshall et al. U.S. Publication 2002/0097259.

Referring to claims 1 and 7, as best understood by the examiner, Marshall et al. teach a system and program product for web based imaging comprising at least one graphic store for storing a plurality of different graphics (memories materials such as those obtained from external sources) (page 2, paragraph 0018 and page 3, paragraph 0030 and further shown in Figure 5); a group composition store that is independent from the at least one graphic store and is for storing a plurality of compositions, with each different composition referencing at least one graphic in the at least one graphic store that is external to the group composition store (the memories product generation system, which can be a stand alone system that is connected to the memories materials of the fulfillment center via a data communications medium, can create products, such as stories using memories materials, such as memories from external sources) (page 2, paragraph 0018, pages 3-4, paragraphs 0028, 0031-0036 and Figure 1B) and including data to place the referenced graphic within the composition (a listing of the various memories

products that can be generated is presented to the customer, with each memories product using at least one of the memories material such as memories materials from external sources) (page 5, paragraphs 0045 and 0047, and page 7, paragraph 0057; this is further shown in Figure 9); and a plurality of different user profiles that are independent from the group composition store and are accessed from at least one user profile store, each for a different imaging client, with each user profile including a reference to the group composition store (each customer is associated with a profile in the Database B-Users database, including the customer's name, email, password, and memories materials and products created by or available to the customer) (pages 3-4, paragraph 0033, page 4, paragraph 0039, page 5, paragraphs 0044-0045 and further shown in Figures 1B and 6). Furthermore, as shown in Figure 1B, it can be seen that the database for memories materials 126, the memories product generation system 129A and the database for user profiles 124 are all independent, as shown by the separate references for each item.

Referring to claims 2 and 8, Marshall et al. teach a default graphics store for at least one of the imaging clients, a default composition store for the at least one imaging client, including a composition therein with a reference to a graphic within a graphics store, and wherein the user profile for the at least one imaging client includes a reference to the default graphic store and the default composition store (the artwork making up the style of the memories material and memories product can be retrieved from a library of design elements offered by the system; therefore, the user does not have to create their own artwork, they can use the default artwork and memories product offered by the system) (page 4, paragraph 0036 and further shown in Figure 11).

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Referring to claims 3 and 9, Marshall et al. teach one or more of the user profiles including a reference to a default composition within said group composition store (customers can use the default artwork and memories product offered by the system and therefore, the user profile associated with that customer would reference the default artwork and memories product) (page 4, paragraph 0036 and further shown in Figure 11).

Referring to claims 4 and 10, Marshall et al. teach a firewall protecting the plurality of imaging clients (page 2, paragraph 0023) and wherein at least one composition in the group composition store references a graphic outside of the firewall (memories material referenced by the memories product generated can be from external sources or resident on the customer's terminal equipment) (page 2, paragraph 0018 and 0024).

Referring to claims 5 and 11, Marshall et al. teach the group composition store containing a method that prevent at least selected ones of the imaging clients from deleting or modifying at least one composition in the group composition store (if users do not have an authenticated ID and password, they are prevented from using the system and consequently modifying the material such as memories material and memories products contained in the system) (page 4, paragraph 0042 and continuing onto the top of page 5).

Referring to claims 6 and 12, Marshall et al. teach a web extension that will enumerate compositions stored in the group composition store as available to the imaging client (page 7, paragraph 0057 and page 8, paragraph 0070 and further shown in Figure 9).

*Response to Arguments*

4. Applicant's arguments filed on 2 July 2004 have been fully considered but they are not persuasive.

5. Applicant asserts that Marshall et al. fails to disclose memory data can be stored on a network service not associated with the Hallmark system. The examiner respectfully disagrees. As recited on page 2, paragraph 0018, memories materials includes information from numerous sources including external sources. Therefore, memories information used to create memories products can be obtained from external services not associated with the Hallmark system. In addition, as shown in Figure 1B, the memories materials database 126, or the graphics data store, of memories materials from external sources, is separate and independent from the Memories Product Generation System 129A, or the group composition store; in other words, as shown by the separate status of the memories database and the memories product generation system, memories materials spanning multiple systems and sources can be used to create a memories product for a user.

6. Applicant also asserts that Marshall et al. fail to teach the user profiles are independent from and not associated with the group composition store. The examiner respectfully disagrees. The user profiles are stored in a Database B Users database, or user profile store, as recited on page 5, paragraph 0044; furthermore, as shown in Figure 1B, Database B Users 124, storing user profiles, are independent and separate from the Memories Product Generation System 129A, or the group composition store.

7. Therefore, it can be seen that the Marshall et al. reference anticipates the subject invention.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 8:30 am - 6:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-4058.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

16 November 2004



**RAYMOND J. BAYERL**  
**PRIMARY EXAMINER**  
**ART UNIT 2173**